

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 30-55 are currently pending. Withdrawn Claims 58-111 have been canceled without prejudice; and Claims 30 and 55 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 30-55 were rejected under 35 U.S.C. § 112, second paragraph, regarding the inputting of opinion information into the inquiry input screen; Claims 30-33 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,908 to Abelow (hereinafter “the ‘908 patent”) in view of U.S. Patent No. 6,012,051 to Sammon, Jr. et al. (hereinafter “the ‘051 patent”); Claims 34, 35, 37, 39, and 43-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908 and ‘051 patents, further in view of U.S. Patent No. 6,578,014 to Murcko, Jr. (hereinafter “the ‘014 patent”); Claims 36, 38, and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of the Palmer reference (“Fancy Labels, Plain Prices”); Claims 41 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of U.S. Patent No. 6,012,045 to Barzalai (hereinafter “the ‘045 patent”); and Claims 51-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of Anonymous (“Fresh Cargo Brand is Renamed”).

Claim 30 is directed to a merchandise planning and development method, comprising:

(1) a merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to design specifications of new merchandise in a development period, through the Internet, and until

before the new merchandise is manufactured; (2) a displaying step of displaying, at a side of the customer, the merchandise planning and development information including a preview design received through the Internet, the displaying step further displaying an inquiry input screen into which the customers input, via the Internet, opinion information, prior to manufacture of the new merchandise, not on use of the new merchandise by the customers, but on the merchandise planning and development information, wherein the opinion information is inputted based on the displayed merchandise planning and development information in the development period of the new merchandise, and wherein the inquiry input screen displayed after the preview design is displayed; (3) receiving, through the Internet, the opinion information input by the customers; (4) an opinion information collecting step of collecting the received opinion information input by the customers, through the Internet; (5) drafting an improved design of the new merchandise using a CAD device, based on an improved specification of the new merchandise determined according to an analysis of the opinion information collected, and (6) a merchandise information notice step of informing the customers of information on the improved design of the new merchandise, through the Internet. The changes to Claim 30 are supported by the originally filed specification and do not add new matter.¹

Applicants respectfully traverse the rejections of Claims 30 and 55 under 35 U.S.C. § 112, second paragraph. Claim 30 recites the step of displaying an inquiry input screen into which the customers input opinion information, and the step of receiving opinion information input by the customers. Claim 30 is merely broad, not indefinite. One of ordinary skill in the art would clearly understand that the inquiry input screen is displayed and opinion information is received. There is no requirement to also recite inputting the opinion information. For example, if the method is performed by a server, the server receives the

¹ See Figure 4, steps SA7 and SA9, p. 48, lines 18-25; page 49, line 21 to page 50, line 6. See also page 56, line 15 to page 57, line 18.

opinion information, but does not input it into the input screen. This is analogous to methods performed by transmitters and receivers that communicate with one another. Under the position taken by the Office, only system claims would be definite, not separate transmitter and receiver claims that referred to signals generated by another device. As stated in the MPEP “a refusal to construe the claims more broadly than is considered warranted by the claim language is not a rejection.” See *In re Volk*, 207 USPQ 1086. Further, Applicants refer the Examiner to method Claim 22 in the ‘051 patent, which is cited in the Office Action. The second step is “generating … a prompt display prompting a user to input data ….” The next step is “receiving and storing input data.” Applicants note that this claim does not positively recite a step of inputting the data. For the reasons stated above, Applicants respectfully traverse the rejection of the claims under 35 U.S.C. §112.

Regarding the rejection of Claim 30 under 35 U.S.C. §103(a), the Office Action asserts that the ‘908 patent discloses everything in Claim 30 with the exception of transmission of data via the Internet, and relies on the ‘051 patent to remedy that deficiency. Further, Applicant notes that the Office Action again cites to columns 48 and 77 of the ‘908 patent as disclosing “customer feedback regarding information and improvements on products before … new merchandise is used.” However, as discussed below, the ‘908 patent does not disclose this limitation, but is merely directed to information provided regarding a customer’s actual use of a product.

Further, Applicant notes that pages 5 and 6 of the outstanding Office Action assert that “information describing the type of information displayed is considered to be non-functional descriptive material.” However, Applicants note that Claim 30 clearly states that opinion information on the merchandise planning and development information, which is input by the users, is received through the Internet, collected through the Internet, and that the customers are notified of information on merchandise designed according to an analysis of

the opinion information, as recited in Claim 30. Thus, Claim 30 clearly uses the opinion information entered by the users in a functional manner to inform the customers of information on merchandise designed according to the analysis of the opinion information. Accordingly, Applicant respectfully submits that the information entered by the customers is functional descriptive material and is functionally involved in the steps recited. Further, Applicant notes that the limitation within the displaying step stating that the display of the inquiry input screen is prior to manufacture of the new merchandise is a limitation as to when the inquiry input screen is displayed, not on the type of information that is displayed. Accordingly, Applicant respectfully submits that this limitation must be given weight and that, as discussed below, the '908 patent does not disclose the inputting of opinion information prior to the manufacture of the new merchandise.

The '908 patent is directed to a customer-based product design module configured to interact with customers, gather information from customers, communicate customer information securely to a vendor or an external third party, construct and transmit new preprogrammed interactions to the customer communication system in a product, and analyze and report customer information. In particular, as shown in Figure 2, the '908 patent discloses a system in which the users of a product may provide feedback information to the product designers while the users are using the product. In particular, the '908 patent discloses a customer-based product design module (CB-PD module) that may be attached to a device or incorporated into a device, such as a fax machine.

The '908 patent discloses that the CB-PD module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights.² In this regard, Applicant notes that Figures 24 and 25, and column 32, lines 51-67 relate to the user providing feedback to the developer based on the user's use of the product. Moreover,

² See '908 patent, column 12, lines 43-46.

Applicant notes that the Office Action has cited to column 48, lines 32-42 and column 77, lines 10-15 as disclosing that “the system accepts customer feedback regarding information and improvements on products before new merchandise is used.”³

However, Applicant notes that the ‘908 patent repeatedly states that the entire purpose of the ‘908 patent is to provide feedback on the use of products while the products are being used. For example, the ‘908 patent states that

[t]he customer design system (CDS) in Figure 1 gives vendors hands-on customer-based information 30 that is generated WHILE THEIR PRODUCTS ARE BEING USED. At their moments of greatest need, customers tell vendors their perceptions, expectations and the short-comings of their products and their associated services 24. They are able to communicate 24, ‘this is what I’m doing to use your product. This is why I need it and why I use it this way. Here are the specific things I’d like you to improve, and why they are important to me. I’d also like to tell you how to improve your relationship with me. Here are the important things I’d like you to do now.’⁴

Further, the Summary of the Invention of the ‘908 patent states that “this customer-based product design module (CB-PD module) invention is designed to embed a new type of product feature within a range of products and services, helping them evolve into customer directed products (CDP) by means of development interactions (DI). The result is a continuous source of aggregate customer desires (ACD) and define customer desires (CDC) from customers and users while they are using these products and services.”⁵

Further, the Abstract of the ‘908 patent describes embedding the invention in products or services and discusses obtaining feedback while the products are being used.

Further, as discussed above, the outstanding Office Action cites to Figures 24 and 25, column 32, column 48, and column 77 as disclosing the inputting of opinion information prior to manufacture of new merchandise in the development period of the new merchandise,

³ See page 4 of the outstanding Office Action.

⁴ ‘908 Patent, col. 18, lines 21-32. Emphasis in original.

⁵ ‘908 Patent, col. 9, lines 18-26. Emphasis added.

However, Applicant notes that Figures 24 and 25 are screens that are displayed while the user is using a software product. In particular, Applicant notes that Figure 25 has a question that says “you just exited on-line help after using it for the first time, please rate the ease or difficulty of finding the help product you needed.” Thus, Claim 25 is clearly related to asking the user how they liked using a particular software product. Further, the passage in column 32 of the ‘908 patent discusses the use of a software product as illustrated in Figure 24. This process is illustrated in Figure 10A and 10B of the ‘908 patent. For example, step 280 in Figure 10A involves the recognizable use of a product or service. See ‘908 patent, column 34, lines 13-15 which states that this process is initiated “when the customer directed product (CDP) is turned on and off, when a particular product feature is used by pressing a particular button, etc.” Again, the passage in column 32 relates to Figure 10A and 10B which describe a flowchart in which a user's use of a product can trigger dialogue screens that ask the users questions about the use of the product.

Further, the passage in column 77, lines 10-15 of the ‘908 patent relates to field testing of prototypes before the product is shipped. However, Applicant notes that field testing still involves use of a product, while Claim 30 requires opinion information to be inputted on the merchandise planning and development information and not on use of the new merchandise. Accordingly, Applicants respectfully submit that the passage in column 77 does not read on the input of information prior to the use of merchandise, since field testing is the use of merchandise.

Further, Applicant notes that the cited section in column 48 of the ‘908 patent relates to ways that a user directs the design evolution of the products, but that all the feedback provided by the user relates to the use of a particular product. In particular, the ‘908 patent discloses in column 48 that the CB-PD module could be programmed to include “what if” opportunities for simulations in using the products in certain ways, which again is

information regarding how an existing product may be used in different ways, but is not based on merchandise planning and development information prior to manufacture or use of new merchandise.

Further, Applicant notes that Claim 30 has been amended to clarify that the inquiry input screen is displayed after the preview design is displayed.

The '051 patent is directed to a system configured to process information to identify product choices within a range of product choices for a user, based on user preferences. Thus, the '051 patent discloses a system that attempts to identify appropriate product choices for a user from a predetermined list of existing products.

However, Applicant respectfully submits that the '051 patent fails to disclose a merchandise planning information notice step of informing many and unspecified users of merchandise planning and development information relating to design specifications of new merchandise in a development period, through the Internet, and until before the new merchandise is manufactured, as recited in amended Claim 30. On the contrary, the '051 system is used by a particular user to select among various products. Further, the '051 patent fails to disclose displaying an inquiry input screen into which the customers input opinion information, prior to manufacture of the new merchandise, not on use of the new merchandise by the customers, but on the merchandise planning and development information, as recited in Claim 30.

Further, Claim 30 has been amended to recite the step of drafting an improved design of the new merchandise using a CAD device, based on an improved specification of the new merchandise determined according to an analysis of the opinion information collected. This step is not disclosed by the '051 or '908 patents, taken either singly or in proper combination.

Accordingly, no matter how the teachings of the '908 and '051 patents are combined, the combination does not teach or suggest a merchandise planning and development method

in which the opinion information is inputted based on display merchandise planning and development information in the development period of the new merchandise, not on use of the new merchandise by the customers, as recited in amended Claim 30. Further, the combined teachings of the '908 and '051 patents fail to disclose an inquiry input screen is displayed after the preview design is displayed, as recited in amended Claim 30. Further, the combined teachings of the '908 and '051 patents fail to disclose drafting an improved design of the new merchandise using a CAD device, based on an improved specification of the new merchandise determined according to an analysis of the opinion information collected. Accordingly, Applicant respectfully submits that the rejection of Claim 30 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 30 and that Claim 30 patentably defines over any proper combination of the '908 and '051 patents.

Independent Claim 55 recites limitations analogous to the limitations recited in amended Claim 30. Moreover, Claim 55 has been amended in a manner analogous to the amendment to Claim 30. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 30, Applicant respectfully submits that the rejection of Claim 55 is rendered moot by the present amendment to that claim.

Regarding the rejection of dependent Claims 34-54 under 35 U.S.C. § 103(a), Applicant respectfully submits that the '014 patent, the '054 patent, and the Palmer and Anonymous references fail to remedy the deficiencies of the '908 and '051 patents, as discussed above. Accordingly, Applicant respectfully submits that the rejections of dependent Claims 34-54 are rendered moot by the present amendment to independent Claim 30.

Thus, it is respectfully submitted that independent Claims 30 and 55 (and all associated dependent claims) patentably define over any proper combination of the cited references.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

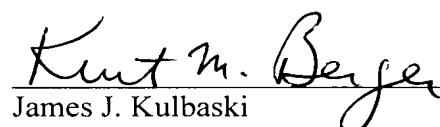
Respectfully submitted,

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